

Amendment and Response

Applicant: Jon Ocel et al.

Serial No.: 10/056,807

Filed: January 25, 2002

Docket No.: M190.134.101

Title: FLUID-ASSISTED ELECTROSURGICAL INSTRUMENT WITH SHAPEABLE ELECTRODE

REMARKS

In the Office Action mailed December 29, 2003, the Examiner rejected claims 1-43. In particular, the Examiner rejected claims 1-4, 7-18, 24-31, and 33-43 under 35 U.S.C. § 102(b) as being anticipated by Hovda et al., U.S. Patent No. 6,053,172 ("Hovda"). Additionally, claims 1-11, 13-16, and 24-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Panescu et al., U.S. Patent No. 5,688,267 ("Panescu"). Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Moaddeb et al., U.S. Patent No. 6,405,078 ("Moaddeb"). Claims 22 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Knoepfler, U.S. Patent No. 5,300,087 ("Knoepfler"). Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Knoepfler in view of Borst et al., U.S. Patent No. 6,328,688 ("Borst"). With this Amendment and Response, claim 1 is amended and claims 44-50 are added. It is believed that all claims are in condition for allowance for at least the reasons stated below.

Claim Rejections under 35 U.S.C. §§102, 103

Claims 1 and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hovda and under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Panescu. Claims 1 and 24 relate, in part, to an electrosurgical instrument including an elongated shaft adapted to be transitionable from, and independently maintain a shape in, a straight state and a first bent state. Claim 39 was also rejected under 35 U.S.C. § 102(b) as being anticipated by Hovda. Claim 39 relates, in part, to a method of performing an electrosurgical procedure, the method comprising providing an electrosurgical instrument including an elongated shaft, and bending the shaft to a first bent state in which a portion of the shaft is deflected relative to a linear axis of the shaft, wherein the shaft independently maintains the shape of the first bent state. For at least the reasons below, the cited references do not expressly or inherently teach or suggest such limitations.

As a basis for the rejection of claim 39, the Examiner states that two distinct bends are possible in Hovda as depicted in Fig. 2 of Hovda. It is unclear how the curves in shaft 100 teach or suggest bending a shaft as required by the limitations of claim 39. According to MPEP §



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2112, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” The mere fact that Hovda shows a bent shaft does not necessitate the conclusion that Hovda teaches bending, much less an electrosurgical procedure that includes bending a shaft adapted to independently maintain such bends.

With further regard to bends in shaft 100, at column 11, lines 29-37, Hovda expressly teaches that shaft 100 be suitably designed to access the larynx by having a specifically designed bend to facilitate handling by the surgeon. The Examiner indicates that such language suggests “pre-surgical manipulation” and malleability. A “specifically designed bend” is more correctly interpreted as teaching a bend that is pre-fabricated into shaft 100 prior to any electrosurgical procedure. Pre-fabricated bends do not teach or suggest an electrosurgical procedure including bending. Hovda also discloses a flexible shaft 100 in the alternative to a shaft having a bend (i.e., “the shaft may be flexible or have a distal bend”). Such “flexibility” similarly fails to teach or suggest bending a shaft that is adapted to independently maintain its shape. As such, it is the Applicant’s position that Hovda specifically teaches away from an electrosurgical procedure including bending a malleable shaft adapted to independently maintain its shape as required by the limitations of claim 39. (2)

In addition to the process of bending discussed above, Hovda fails to teach or suggest a shaft adapted to be transitionable from, and independently maintain its shape in, a straight state and a first bent state as required by claims 1 and 24. To the contrary, Hovda’s shaft is either permanently bent or entirely flexible. As such, Hovda’s failure to teach or suggest such limitations is relevant to the Examiner’s rejection of those claims under 35 U.S.C. §§ 102 and 103 as well.

In particular, the Examiner opines that the disclosed materials that constitute the Hovda shaft are equivalent to those that constitute the Applicant’s shaft. The Examiner then proffers that from this, Hovda is at the very least capable of being transitionable from a straight state to a first bent state and able to independently maintain distinct shapes. The Examiner cites the Applicant’s Response dated 7-16-03 for such a conclusion. However, in that Response the

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Applicant submitted that the “electrode body 60 is formed of a material, such as stainless steel or nitinol, which is malleable.”

In light of that Response and the Specification at page 13, lines 22-28, Hovda fails to disclose metals having equivalent malleability. Hovda merely teaches or suggest, for example, stainless steel, not stainless steel that is sufficiently malleable to be bent as part of an electrosurgical procedure while also adapted to independently maintain its shape. According MPEP § 2112, *quoting Ex parte Levy*, 17 USPQ2d 1461 (Pd Pat. App. & Inter. 1990), “[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support that determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Clearly, broadly disclosing titanium alloys or nickel alloys fails to teach or suggest the limitations of claims 1, 24, and 39 as such limitations do not “necessarily flow” from the Hovda disclosure. Titanium alloys, nickel alloys, and stainless steels include both rigid versions as well as malleable versions. If the Examiner’s position were correct, merely disclosing a shaft made of “metal” would be sufficient to teach malleable metals. However, without more (such as disclosing the desirability of malleable alloys, a bendable characteristic or an analogous bending process) the limitations of claims 1, 24, and 39 do not necessarily flow from the materials disclosed in Hovda.

For at least the reasons outlined above it is believed that independent claims 1, 24, and 39 present patentably distinct material from the cited references. As claims 2-23, 25-38, and 40-43 depend from claims 1, 24, and 39, they are believed to present patentably distinct matter for similar reasons. As such, the Examiner’s rejection of claims 1-43 is respectfully traversed and allowance of those claims is requested.

Newly added claims 44-50 depend from independent claims 1 and 39. It is believed that these claims are supported by the Specification, for example at page 18, lines 20-24, such that no new matter is added. For at least the reasons described in associate with claims 1 and 37 they are believed to present patentably distinct matter from the cited references. Further, regarding newly presented claims 44 – 47, it is noted that even if, as argued by the Examiner, two distinct bends in Hovda are “possible”, this clearly does not teach or suggest the methods of effectuating these bends as set forth in claims 44 – 47. To the contrary, the non-flexible version of the Hovda shaft

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is provided to the surgeon as either permanently straight or with permanent, pre-formed bends. Hovda does not even imply that the surgeon (or others) can subsequently manually bend this non-flexible shaft version, let alone teach techniques for doing so. Similarly, Hovda does not teach or suggest changing the bend angle of a pre-formed bend in the non-flexible version of the Hovda shaft as otherwise recited in claim 48. Claims 49 and 50 incorporate additional limitations not taught by Hovda.

CONCLUSION

It is believed that all claims are now in a condition for allowance. Notice to that effect is respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 the amount of \$126.00 to cover the additional claim fees.

The Examiner is invited to contact the Applicant's Representative at the below-listed telephone number if there are any questions regarding this response.

Respectfully submitted,

Jon Ocel et al.,

By their attorneys,

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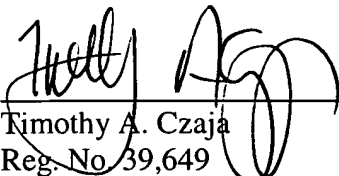
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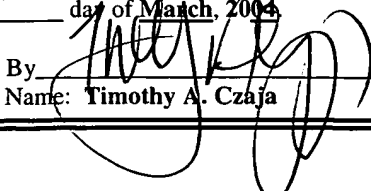
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of March, 2004.

By 
Name: Timothy A. Czaja